

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

REMARKS

This reply is being entered in response to the Office Action of May 25, 2005. In this Office Action, the Examiner made the following rejection:

Claims 1-32 were rejected as allegedly obvious in view of Benson (USP
5 6,334,118) in further view of Brunner (6,185,414).

Included in this amendment are arguments directed to the non-obviousness of the previously presented claims. Furthermore, while applicants do not necessarily agree that the claims as un-amended are obvious, to facilitate the prosecution of this application, the claims have been amended to recite
10 limitations that further distinguish the instant invention from the prior art of record.

Independent claims 1, 12 and 22 have been recited to include various limitations not found in the prior art of record. These limitations include, for example; connecting and disconnecting to the authentication server, reconnecting to the server to perform a time credit, and activating the software
15 for a total amount of time requested while the software is not connected to the server. Reconsideration is respectfully requested.

1. REJECTION OF CLAIMS 1, 6, 12 AND 22 IN VIEW OF BENSON AND BRUNNER

20 The Examiner has rejected claims 1, 6, 12, and 22 as allegedly obvious in view of Benson in further view of Brunner, stating:

25 As per claim 1, 6, 12, and 22, Benson et al teach a method for licensing time-based software comprising the loading time-based software onto a client machine, wherein the time-based software submits user information including an amount of time request by the user for using the time based software to an authentication server through a network/internet,
30 determining if the user is approved, wherein if the user is approved, further comprising the step of: the authentication server activating the time-based software for an amount of time approved (see abstract, column 1 lines 28-42, 3 lines 55-4, line 25,
35 14 lines 25-65. Benson et al fail to teach an inventive concept wherein if the user uses the time-based

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

5 software for less than the amount of time approved,
the user crediting any amount of time back to the
authenticating server. However, Brunner et al
teaches an inventive concept to teach an inventive
concept wherein if the user uses the time-based
software for less than the amount of time approved,
the user crediting any amount of time back to the
authenticating server (see claim 25). Therefore it
10 would have been obvious to one of ordinary skill in
the art at the time the invention was made to modify
the inventive concept Benson et al to include Brunner
et al's teach an inventive concept wherein if the user
uses the time-based software for less than the
amount of time approved, the user crediting any
15 amount of time back to the authenticating server
because this would have ensure that the appropriate
allocated for the use of the software/application is
properly used so that the system would have
additional time to allocate to other user of the
20 systems.

The applicant respectfully disagrees that the claimed invention is obvious
in view of the teachings of Benson in further view of the teachings of Brunner.
For an obviousness rejection to be tenable, three criteria must be present in the
25 references cited by the Examiner. Reference may be had to MPEP § 2143 which
states:

30 To establish a *prima facie* case of obviousness, three
basic criteria must be met. First, there must be some
suggestion or motivation, either in the references
themselves or in the knowledge generally available to
one of ordinary skill in the art, to modify the reference
or to combine reference teachings. Second, there
must be a reasonable expectation of success.
35 Finally, the prior art reference (or references when
combined) must teach or suggest all the claim
limitations). The teachings or suggestion to make the
claimed combination and the reasonable expectation
of success must both be found in the prior art, not in
40 the applicant's disclosure." *In re Vaeck*, 947, F.2d
488, 20 USPQ2d 1438 (Fed. Circ. 1991).

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

It is therefore clear that three basic requirements must be met for an obviousness rejection to be tenable;

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (2) There must be a reasonable expectation of success.
- (3) The prior art reference (or references when combined) must teach or suggest all the claim limitations).

The applicant notes that if even one of the above three requirements are not present, then an obviousness rejection is improper and should be withdrawn. It is respectfully submitted that none of the three requirements are present. Each of these requirements will be addressed in turn elsewhere in this specification.

NO SUGGESTION OR MOTIVATION TO COMBINE

There is no suggestion or motivation present in the references that would suggest their combination. Absent such a suggestion, it is improper to combine those references.

The Examiner asserted in the Office Action on page 3, beginning at line 7, that Benson did not teach a time crediting aspect. The Examiner then asserted that Brunner teaches a time crediting aspect. With no supporting evidence, the examiner then concluded that it would have been obvious to combine the inventions of Benson and Brunner. Simply combining two references, with no rationale as to why one of ordinary skill in the art would be motivated to do so, is improper. Reference may be had to MPEP § 2143.01 which states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916, F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

Benson is silent with regard to crediting unused time, and as such, contains no suggestion to include such an element. Brunner is silent with regard to a software rental system, and as such, contains no suggestion to include such an element. The only way one could be motivated to combine the Benson and
5 Brunner references is to read the applicants disclosure; such a reading of the prior art would require the use of impermissible hindsight, which is impermissible. Reference may be had to MPEP § 2142.

10 To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual
15 information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct
20 the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible
25 hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

THE BRUNNER REFERENCE IS DRAWN FROM A NON-ANALOGOUS ART

30 As part of an obviousness inquiry, the Examiner must provide a suggestion or motivation that is found in the prior art of record that would have prompted one of ordinary skill in the art to combine the cited references. When searching the prior art, the Examiner must cite references that are within the field of the present invention or in a field analogous thereto. Reference may be had to
35 MPEP § 2141.01(a) which states:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992)

The present invention is related to a system for software rental. The Brunner reference is unrelated to any software rental system and is, instead, directed to a telecommunication system. Applicant respectfully submits that one of ordinary skill in the art of software rental systems would not be motivated to search the non-analogous telecommunication art. The solutions provided by the telecommunication art are so far removed (i.e. non-analogous) from the solutions required in the software rental systems, that, if the telecommunication teachings were applied to the software rental system, the resulting combination would be non-functional.

USING THE TIME CREDITING METHOD OF BRUNNER WOULD NOT PROVIDE A REASONABLE EXPECTATION OF SUCCESS

The applicant notes that the time crediting method of Brunner is incompatible with the present invention, and would not provide a reasonable expectation of success. This is due, at least in part, to the fact that the technology of Brunner is from a non-analogous art. Brunner's telecommunication time crediting method automatically credits time immediately prior to disconnecting the telephone call, regardless of the user's desires. In contrast, the amended claims (see, for example, claim 22) recite a limitation wherein the time-based software disconnects from the server, but no time is credited until the user (1) disconnects from the server, (2) uses some of the time, and (3) reconnects to the server to proactively credit time. Indeed, crediting time immediately prior to disconnection from the server (as per the teaching of Brunner) would cause the present invention's time crediting mechanism to not

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

function properly, as time may be credited before any time had actually been used! The apparent paradox described above is due to the fact that Brunner's time crediting method is from an art which is non-analogous with that of the present invention. It is respectfully submitted that the Brunner reference is from
5 a non-analogous field and should not be used in an obviousness rejection of the present claims. Moreover, even if the time crediting of method were used (despite it being from a non-analogous field), one of ordinary skill in the art would not have a reasonable expectation of success, as the timing of the crediting step is fundamentally incorrect. Applicants believe the obviousness rejection should
10 be withdrawn.

THE REFERENCES TEACH AWAY FROM THEIR COMBINATION

To combine the inventions of Benson and Brunner so as to credit back unused time, it would be necessary to alter the audit trails of Benson. Benson
15 teaches away from such modifications. Reference may be had to column 7, beginning at line 62 of the Benson patent. When a reference teaches away from such modifications, it is improper to perform such modifications. Reference may be had to MPEP § 2145(X)(D)(2) which states

20 It is improper to combine references wherein the references teach away from their combination. *In re Grasselli*, 713, F.2d 731, 743, 218 USPQ 769, 779 (Fed. Circ. 1983).

25 If the device of Benson were modified so as to allow the user to credit unused time, such a modification would open a security hole in Benson's invention; precisely what Benson is trying to avoid. To avoid such security breaches, Benson discloses three desirable properties; (1) no holes on the audit trail; (2) the audit trail cannot be modified; and (3) the audit trail is current. See
30 column 8 of Benson, beginning at line 6, which states:

These three properties remove all incentive for an attacker to corrupt, delete, lose or otherwise abuse the audit trail 108.

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

If Benson were modified so as to enable crediting unused time back to the server (i.e. modifying the audit trail), such a modification would provide an attacker with an incentive to corrupt or otherwise abuse the audit trail of Benson.

5 Benson specifically wishes to avoid such modifications.

ALL LIMITATIONS ARE NOT TAUGHT OR SUGGESTED BY THE PRIOR ART OF RECORD

Even if, for the sake of argument, one were to assume that the Brunner
10 reference does contain a suggestion or motivation to be combined with the Benson reference, and even if one should further assume that the Brunner reference is in a field that is analogous to software rental, and even if one should further assume that one of ordinary skill in the art would have a reasonable expectation of successfully combining the references, then the obviousness
15 rejection is still not tenable as the combination of references would still not result in all of the claimed limitations. In the present case, the prior art of record fails to disclose the element of "the user crediting any remaining amount of time back to the authentication server." This issue was first brought to the Examiner's attention in the Amendment of January 24, 2005 (received by Patent Office on
20 January 26, 2005), wherein the applicant stated (beginning on page 12 at line 9):

25 Mostly importantly, Benson fails to disclose or suggest wherein a user credits back any unused approved time to the authentication server, as presently claimed. Unlike Benson, the present invention allows the user to proactively and interactively decide whether or not to re-deposit any unused time. Advantageously, this permits the user to maintain his/her own record, which facilitates, e.g.,
30 a redundancy check of accounting information rather than relying solely on the accuracy of the server, an audit trail or other backup media. (emphasis in original)

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

In the May 25, 2005 Office Action (see, for example page 3, beginning at line 7), the Examiner acknowledged that Benson does not teach such a concept by stating:

5 Benson et al fail to teach an inventive concept wherein if the user uses the time-based software for less than the amount of time approved, the user crediting any amount of time back to the authenticating server.

10 The Examiner then asserted that Brunner teaches such a limitation (the Examiner referenced claim 25, but applicants believe the Examiner intended to properly refer to claim 26), and argues that is it obvious to combine the inventions of Brunner and Benson. The applicant notes that no such limitation is
15 taught in Brunner.

Brunner discloses and claims a pre-paid telephone communication system which changes the rate at which time units are withdrawn from a bank of time credits. Unused time credits are credited back to the user automatically by the system, regardless of the desires of the user. Reference may be had to column
20 6 of Brunner beginning at line 58, which states:

At the end of the call, the timer 62 forwards a signal to the database 58 associated with the unused time still available as credit to the prepaid subscriber.

25 Cleary, it is not the user who proactively credits the time, as recited in the previously presented claims. In contrast, it is the system itself which, irrespective of the desires of the user, credits the time. Nowhere in the disclosure of either Brunner or Benson is the concept of the user crediting the time taught or
30 suggested. Without such a limitation being taught or suggested, an obviousness rejection is untenable, and should be withdrawn.

Not only does the prior art not teach the user proactively crediting time, but a software based time request is also not taught. The prior art of record fails to disclose the element of "said time-based software requests user information
35 including an amount of time requested by the user for using said time-based

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

software." (emphasis added) In the device of Benson, it is the user, and not the time-based software which requests an amount of time. Reference may be had to column 7, beginning at line 15 of Benson, which states:

5 First, the customer 402 sends a request to rent the
software to the vendor 401 in an order request 403.
In this example, the customer 402 purchases six
hours of the application 404. After receiving payment,
10 the vendor 401 sends to the customer 402 a key file
404 that contains a usage authorization. (emphasis
added)

From the above paragraph it is clear that Benson's key file contains the amount of time that the customer requested. It is also clear that the time-based
15 software of Benson in no way requests an amount of time from the user. The interaction in Benson is solely between the customer and the vendor; the time-based software is not involved. The previously presented claims recite such a limitation. Without such a limitation being taught, an obviousness rejection is untenable, and should be withdrawn.

20 Applicants respectfully submit that the claims, as previously presented, are patentable over the prior art of record. Nevertheless, to facilitate the prosecution of this application, the applicant has amended the claims to further distinguish the instant invention from the prior art.

25 **ADDITIONAL LIMITATIONS ADDED THAT FURTHER DISTINGUISH THE INVENTION**

Claims 1, 12 and 22 have been amended to recite an additional limitation; wherein the time-based software connects to the authentication server to receive the time approved, and thereafter disconnects from the authentication server
30 during the normal operation of the software. Bases for this amendment may be found in the specification as filed (see, for example, paragraphs 0014, 0031, and the like of the applicant's published application 2002/0120578A1). Even if, for the sake of argument, one were to assume that the limitations of "the user crediting any remaining amount of time back to the authentication server" and

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

further assume that the limitation of "said time-based software requests user information including an amount of time requested by the user for using said time-based software" are both taught in the prior art of record (which they clearly are not), and further assume that the combination of the non-analogous references is proper (which it clearly is not), and even if one were to assume that there is a reasonable expectation of success (which there clearly is not), and even if one were to further assume that the combination of references produces the previously presented claims, then applicants would note that the prior art of record does not contain the new limitations that are present in the amended claims.

With regard to claim 1, the applicant has amended the claim to recite the limitation that the time-based software disconnects from the server after the software is activated. Benson does not teach such a limitation. As no such limitation is present in the prior art of record, an obviousness rejection is improper.

The applicant would also note that it would be non-obvious to modify the invention of Benson so as to obtain the invention as recited in the amended claims. Such a modification of Benson would require the invention be disconnected from the network and such a modification would be contrary to the principle of operation of Benson. Such modifications are improper. Reference may be had to MPEP § 2143.01 which states:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270, F.2d 810, 123 USPQ 349 (CCPA 1959)

Benson's approach requires constant communication between the remote rental server which hosts the audit trail (see column 10, line 10; and the like) and the local client machine. See column 1, line 37 where Benson states "...the software continually monitors the audit trails to determine when a threshold is exceeded." (emphasis added) If the invention of Benson were disconnected from

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

its supporting network, communication between the server and client would be disrupted, and the software would not be able to verify the audit trail. Thereafter, the software would cease to function. To perform its intended purpose, the software application of Benson needs continual access to these audit trails to
5 check for accuracy (see column 7, line 25).

Similarly, the telephone system of Brunner fundamentally relies on a continual network connection. Reference may be had to the abstract of Brunner "The switching node continually generates real-time call event Date Message Handler..."; column 2, line 31 "...call event generation means for continually
10 generating real-time call event messages..." and the like (emphasis added). Clearly, the disclosure of Brunner is completely and entirely directed toward real-time temporal measurements. Nowhere does Brunner teach or suggest connecting and subsequently disconnecting from the network. Indeed, such a connection/disconnection method would be contrary to the principle of operation
15 of the telephone system of Brunner. The invention of Brunner relies upon a continual, real-time telephone call to function properly. To obtain all of the limitations recited in the amended claims, Brunner's telephone invention would need to be modified so as to (1) call the authentication server to receive a time credit (2) disconnect from the authentication server after receiving a time credit
20 (3) use the time credit to complete the primary telephone call (4) disconnect from the primary telephone call, (5) the user then credits the unused time back to the authentication server.

The principle of operation of the Brunner device was to, in part, permit "...for prepaid subscribers to access prepaid services while roaming." Brunner
25 teaches the altering of billing information in real-time without interrupting the telephone call. Clearly, modification of the Brunner invention which specifically adds interruptions to the network connection would be contrary to its principle of operation and thus improper.

With regard to claim 12, the applicant has amended claim 12 to include all
30 of the limitations added to claim 1. As applicant believes claim 1 is allowable, claim 12 is allowable for at least the same reasons. In addition, claim 12 has

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

been amended to include limitations not found in claim 1. These limitations more clearly distinguish the applicant's invention from the prior art of record.

Claim 12 has been amended to recite the limitations found in claim 1, and further amended to recite the limitation of reconnecting to the server to credit
5 back unused time. Such a limitation is not taught in the prior art of record. As such, any obviousness rejection which is based on the prior art of record must fail.

The applicant would also note that it would be non-obvious to modify the invention of Brunner so as to obtain the invention as recited in the amended
10 claims. To obtain the invention as recited in the amended claims, the device of Brunner would need to be modified in such a way that it disconnects from the network, and subsequently reconnects to credit unused time. The applicant would note that such a modification would be contrary to the principle of operation of Brunner. As already discussed, such modifications are improper.

15 The Brunner reference relies upon a single, continuous, real-time telephone call. Specifically adding disconnection and reconnection steps into the invention of Brunner would render it unsuitable for its intended purpose. To obtain all of the limitations recited in the amended claims, Brunner's telephone invention would need to be modified so as to (1) call the authentication server to
20 receive a time credit (2) disconnect from the authentication server after receiving a time credit (3) use the time credit to complete the primary telephone call (4) disconnect from the primary telephone call, (5) the user would reconnect to the server, and (6) the user then credits the unused time back to the authentication server. As already discussed, this constant interruption of network connection is
25 contrary to the principle of operation of Brunner. Such modifications, should the Examiner suggest them, would be improper.

With regard to claim 22 the applicant has amended claim 22 to include all of the limitations added to claim 1 and claim 12. As applicant believes claims 1 and 12 are allowable, claim 22 is allowable for at least the same reasons. In
30 addition, claim 22 has been amended to include limitations not found in claim 1

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

or claim 12. These limitations more clearly distinguish the applicant's invention from the prior art of record.

Claim 22 has been amended to recite the limitations found in claim 1 and 12, and further amended to recite the limitation of "the time-based software remains activated for the amount of time requested while disconnected from the authentication server." The amended claim also recites the limitation that the software is activated for the total amount of time requested. Such a limitation is not taught in the prior art of record. As such, any obviousness rejection which is based on the prior art of record must fail.

The applicant would also note that it would be non-obvious to modify the invention of Benson so as to obtain the invention as recited in the amended claims. To obtain the invention as recited in the amended claims, the device of Benson would need to be modified in such a way that it activates the software for the total amount of time requested while the software is disconnected from the server. The applicant would note that such a modification would be contrary to the principle of operation of Benson. As already discussed, such modifications are improper. Additionally, such a modification of Benson would render the invention of Benson unsatisfactory for its intended purpose. Such modifications are also improper. Reference may be had to MPEP § 2143.01 which states:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Circ. 1984)

The invention of Benson teaches the user requesting a total amount of time (for example, 6 hours). The invention of Benson requires that the smart card communicate with the remote server at regular time intervals (for example, 15 minutes). For Benson, this constant communication is critical and required for proper creation of the audit trails. The invention of Benson could not function, and would be rendered unsatisfactory for its intended purpose, if the software of Benson were activated for the entire amount of time requested (for example, 6

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

hours) without reconnecting to the server to write an audit trail. Such a modification, should the Examiner suggest them, would clearly be improper.

The applicant respectfully submits that claims 1, 12 and 22 were non-obvious in view of the prior art of record as previously presented. Nevertheless, applicants have amended the independent claims 1, 12 and 22 to further distinguish from the prior art of record. It is respectfully submitted that independent claims 1, 12 and 22, and their corresponding dependent claims, are now in condition for allowance.

The applicant has also restructured the claim dependency of several of the dependent claims. Reconsideration of these restructured claims is respectfully requested.

2. REJECTION OF CLAIM 2 IN VIEW OF BENSON AND BRUNNER

The Examiner has rejected claim 2 in view of Benson in further view of Brunner, stating:

As per claim 2, Benson et al teach a method wherein if the user is not approved, further comprising the step of sending a rejection message back to the software see abstract, column 1 lines 28-42, 3 line 55-4 line 25, 14 lines 25-65).

The applicant notes that claim 2 is dependent upon claim 1, and as such, contains all of the limitations of claim 1. As already discussed, applicants believe claim 1 is allowable as not all of the limitations recited in the amended claims is present in the prior art. As claim 2 contains all of the recited limitations, applicant respectfully submits that claim 2 is also in condition for allowance.

3. REJECTION OF CLAIMS 3, 13 AND 23 IN VIEW OF BENSON AND BRUNNER

The Examiner has rejected claims 3, 13 and 23 in view of Benson in further view of Brunner, stating:

As per claim 3, 13 and 23, Benson et al teach a method wherein the step of determining if the user is

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

5

approved further comprises the steps of: matching the user information with a user account stored in the authentication server; and checking the user account for a time credit amount, wherein the user is approved if the user information matches the user account and the time credit amount is greater than zero (see paragraphs 0049, 0050).

10 Applicant notes that claims 3, 13 and 23 are dependent, either directly or indirectly, upon allowable independent claims. As such, claims 3, 13 and 23 contain all of the limitations of those independent claims, and are therefore, also allowable.

15 Applicants would also like to note for the record that it appears the reference to paragraphs 0049 and 0050 is in error. The aforementioned paragraphs appear to be an artifact from a previous office action.

4. REJECTION OF CLAIMS 4 AND 14 IN VIEW OF BENSON AND BRUNNER

The Examiner has rejected claims 4 and 14 in view of Benson in further view of Brunner, stating:

20

As per claim 4, 14, Benson et al teach a method wherein the user information comprises a user name, a password, and an amount of time requested see abstract, column 1 lines 28-42, 3 line 55-4 line 25, 14 lines 25-65).

25

30 The applicant respectfully disagrees that Benson teaches the claimed elements. Benson uses a smart card and asymmetric cryptography, and thus avoids the use of user names and passwords. Instead, the device of Benson uses a combination of public and private keys, both of which are selected by the vendor and not by the user. The public/private keys and amount of time credit are a function of the smart card which is encoded by the vendor. In contrast, the present invention utilizes a user name, password, and time request, all of which are determined by the user. Reference may be had to the applicant's published
35 specification at paragraph 0028, which states:

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

5 Once the time-based software is downloaded to a user's machine, the time-based software will ask the user for, for example, user information (step 101). The user information may comprise, for example, a username of the user account, a password for the user account, and an amount of time requested (e.g., in minutes) for using the software.

10 Moreover, it is clear from the specification of Benson that the amount of time increments sold is determined by the vendor, and not by the user. Reference may be had to Benson, column 7, beginning at line 13. In the example provided Benson indicates that the vendor sells time in six hour increments. It is the vendor who determines the amount of time to be purchased, not the user. This is in contrast to the previously presented claims which clearly
15 indicate that the time-based software prompts the user for an amount of time to be requested. In this manner, the user may purchase time in any time increment desired. The applicant respectfully submits that an obviousness rejection of claims 4 and 14 in view of Benson and Brunner is improper wherein the cited references do not teach all elements recited in the previously presented claims.
20 Nevertheless, in an earnest effort to facilitate prosecution of this application, the applicant has amended claim 14 to recite that it is the user to select the user name and password. Bases for this amendment may be found in the specification as filed. See, for example, paragraph 0028 of the applicant's published application.
25 Applicant respectfully submits that the claims as previously presented are patentable in view of the prior art of record, as the prior art fails to teach all of the claimed limitations. In addition, applicant has amended the claims so as to more early distinguish from the prior art of record. It is respectfully submitted that the obviousness rejection has been obviated.

30

5. REJECTION OF CLAIMS 5, 15 AND 24 IN VIEW OF BENSON AND BRUNNER

The Examiner has rejected claims 5, 15 and 24 in view of Benson in further view of Brunner, stating:

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

5 As per claim 5, 15 and 24, Benson et al teach a method wherein if the user uses the time-based software for less than the amount of time approved, further comprising the step of crediting any remaining amount of time back to the authentication server see abstract, column 1 lines 28-42, 3 line 55-4 line 25, 14 lines 25-65).

10 Applicant respectfully submits that the Examiner has already acknowledged that Benson does not teach such an element. In the May 25, 2005 Office Action (see, for example page 3, beginning at line 7), the Examiner acknowledged that Benson does not teach such a concept by stating:

15 Benson et al fail to teach an inventive concept wherein if the user uses the time-based software for less than the amount of time approved, the user crediting any amount of time back to the authenticating server.

20 It is respectfully submitted that for this reason alone the rejection of claims 5, 15 and 24 is improper.

Moreover, applicant notes that the amendment of November 5, 2004 canceled claims 5, 15 and 24. Applicants respectfully submit that it is improper
25 to reject claims which have been previously canceled and are not being re-presented. Applicants believe the rejection of claims 5, 15 and 24 is improper and should be withdrawn.

30 **6. REJECTION OF CLAIMS 7, 18 AND 25 IN VIEW OF BENSON AND BRUNNER**

The Examiner has rejected claims 7, 18 and 25 in view of Benson in further view of Brunner, stating:

35 As per claim 7, 18 and 25, Benson et al teach a method wherein the step of the time-based software submitting user information to the authentication server further comprises submitting order information to the authentication server, the order information comprising a software product ID and a client

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

machine IP address see abstract, column 1 lines 28-42, 3 line 55-4 line 25, 14 lines 25-65).

The applicant has studied the disclosure of Benson and notes that
5 nowhere in the specification is any reference to a client machine IP address made. If the claimed element is not taught or suggested in the references cited by the Examiner, then an obviousness rejection based on those references is improper. Applicant respectfully requests that the obviousness rejection be withdrawn.

10

7. REJECTION OF CLAIMS 8, 19 AND 26 IN VIEW OF BENSON AND BRUNNER

The Examiner has rejected claims 8, 19 and 26 in view of Benson in further view of Brunner, stating:

15

As per claim 8, 19 and 26, Benson et al teach a method wherein the time-based software displays a log-in access box for requesting the user information, the log-in access box including a balance checking feature for allowing the user to check a total amount of time remaining in a user account see abstract, column 1 lines 28-42, 3 line 55-4 line 25, 14 lines 25-65).

20

25 The applicant has studied the disclosure of Benson and notes that the specification does not teach a log-in access box of any kind. As a log-in access box is not taught, it follows that Benson does not disclose a log-in access box that includes a balance checking feature. The applicants have studied the paragraphs referenced by the Examiner as well as the rest of the Benson reference, and it is unclear how the Examiner arrived at the conclusion that the
30 disputed limitation is present. Absent such evidence from the Examiner, applicants believe that the rejection of the present claims is improper and should be withdrawn.

8. REJECTION OF CLAIMS 9, 17 AND 27 IN VIEW OF BENSON AND BRUNNER

35

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

The Examiner has rejected claims 9, 17 and 27 in view of Benson in further view of Brunner, stating:

5 As per claim 9, 17 and 27, Benson et al teach a method wherein if the user is approved, further comprising the step of updating a time credit amount in the authentication server see abstract, column 1 lines 28-42, 3 line 55-4 line 25, 14 lines 25-65.

10 Applicants note that the time credit taught in Benson is a fixed value which is never updated. Instead, Benson discloses the creation of a multitude of audit trails at set intervals. Based on the number of audit trails and the value of the set interval, one can calculate the time the time-based software has been used for. See Benson, column 7, beginning at line 25. This calculated value is compared
15 to the time credit amount stored in the server, which is a fixed value that is never changed. It is therefore clear that the time credit, as taught by Benson, is never updated, as recited in the previously presented claims.

 As the prior art of record fails to teach all of the claimed elements, an obviousness rejection based on those elements is improper. Applicant
20 respectfully submits that the obviousness rejection should be withdrawn.

9. REJECTION OF CLAIMS 10, 20 AND 28 IN VIEW OF BENSON AND BRUNNER

 The Examiner has rejected claims 10, 20 and 28 in view of Benson in
25 further view of Brunner, stating:

 As per claim 10, 20 and 28, Benson teach a method wherein if the time credit is greater than or equal to the amount of time requested, the amount of time approved comprises the amount of time requested see abstract, column 1 lines 28-42, 3 line 55-4 line 25,
30 14 lines 25-65).

 As previously discussed, Benson teaches that the amount of time credit is
35 a fixed value. As such, the amount of time approved by the device of Benson is always equal to the time credit. As per the example provided by Benson at column 7, beginning at line 13, the user purchases a smart card from the vendor

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

which approves six hours of time credit. The user will have six hours of time credit encoded into the smart card. The user is unable to request five hours of time credit, as the six hour time credit is fixed. Claims 10, 20 and 28 each recite the limitation of withdrawing an amount of time which may or may not be the same as the total time credit. The disclosure of Benson does not disclose such a capability, and therefore does not teach the claimed limitation. For at least this reason, the applicant believes claims 10, 20 and 28 are allowable.

While the applicant does not necessary agree that the aforementioned obviousness rejection is proper, the applicant has amended the language of claim 28 to recite the limitation that the amount of time approved consists of the amount of time requested. This is in stark contrast to the device of Benson wherein the amount of time approved is a fixed value, which is not subject to a request made by the time-based software.

Applicant respectfully submits that the claims as previously presented are allowable over the prior art of record. Furthermore, the applicant has amended selected claims to further distinguish over the prior art of record. It is respectfully submitted that the obviousness rejection has been obviated.

10. REJECTION OF CLAIMS 11, 21 AND 29 IN VIEW OF BENSON AND BRUNNER

The Examiner has rejected claims 11, 21 and 29 in view of Benson in further view of Brunner, stating:

As per claim 11, 21 and 29, Benson et al teach a method wherein if the time credit is less than the amount of time requested, the amount of time approved comprises the time credit see abstract, column 1 lines 28-42, 3 line 55-4 line 25, 14 lines 25-65).

As previously discussed, the device of Benson does not permit the time-based software to request time. As Benson does not teach any time request, it is therefore impossible to request more time than is present in the time credit. For

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

example, and with reference to column 7 of Benson, if the time credit is six hours, the time-based software is unable to request seven hours of time.

11. REJECTION OF CLAIMS 30-32 IN VIEW OF BENSON AND BRUNNER

5 The Examiner has rejected claims 30-32 in view of Benson in further view of Brunner, stating:

10 As per claims 30-32, Benson et al teach a method wherein the user is determined to be approved independent of a time and data [sic] the user makes the request for using the software see abstract, column 1 lines 28-42, 3 line 55-4 line 25, 14 lines 25-65).

15 Applicant notes that claims 30-32 are dependent, either directly or indirectly, upon allowable independent claims. As such, claims 30-32 contain all of the limitations of those independent claims, and are therefore, also allowable.

CONCLUSION

20 Applicant has included herewith, arguments directed to the alleged obviousness of the previously presented claims. The applicant has noted that the prior art of record does not contain all of the claimed limitations. In addition, the applicant has amended the claims so as to recite limitations which are also not found in the prior art of record. Moreover, the new limitations are of such a
25 nature that modification of the prior art so as to obtain the claimed invention would cause the prior art devices to no longer function in their intended manner. Such a modification is impermissible.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. If, for any reason, the Patent Examiner
30 believes that a telephone conference with applicants' agent might in any way facilitate the prosecution of this case, the Examiner is respectfully requested to call the undersigned.

To the extent necessary, please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to


Page 27 of 28

Application No.: 09/989,932
Date of Response: 7/26/2005
Reply to Action of: 05/25/2005

Deposit Account 50-2753 and credit any excess fees to such deposit account. If necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made.

5

Respectfully submitted,
Howard J. Greenwald P.C.

By 

10

Peter J. Mikesell
Reg. No. 54,311
Telephone (585) 387-0285
Fax (585) 387-0288